

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Attorney Docket No.
BOBBIE JOE BOWDEN B-0106.01

Serial No.: 08/050,527 Examiner:
Filed: April 19, 1993 T.H. Tubbesing

For: AUTOMATIC DRILLING SYSTEM \$

SUPPLEMENTAL DECLARATION OF DONALD R. COMUZZI

COMMISSIONER OF PATENTS
AND TRADEMARKS
Washington, D.C. 20231

Attn: Licensing and Review

Sir:

I, DONALD R. COMUZZI, declare as follows:

I am a patent attorney registered to practice before the United States Patent and Trademark Office, registration number 22,852, and I represent Applicant, Bobbie Joe Bowden, in the above referenced application.

As previously stated in my prior declaration, Applicant contacted me in late March of 1993 and requested that I prepare patent applications for filing both in the United States and Canada. Both the U.S. and Canadian Applications had to be filed no later than April 19, 1993 to avoid statutory bars in each of those countries. Both the U.S. and Canadian applications were completed and filed on their common statutory bar date of April 19, 1993.

The Canadian application was filed without the proper prospective foreign filing license due to my mistake regarding the proper PTO procedure for the filing of foreign patent applications prior to or contemporaneously with its corresponding U.S. application. At the time of the proscribed Canadian filing, I knew that a foreign filing license was required, however, I mistakenly believed that no such license could be obtained until there was a corresponding U.S. application on file in the U.S. Patent and Trademark Office. I believed the proper procedure to cover contemporaneous filings of U.S. and foreign patent applications was to file the foreign patent application and then seek a retroactive license under 35 USC §184. Thus, although I considered the

(A)(3)(ii)

necessity of a foreign filing license for the Canadian patent application, I believed the only way to protect the patent rights of my client was to file both applications simultaneously and then seek a retroactive foreign filing license.

In an attempt to comply with the PTO procedures I believed were correct in handling a foreign statutory bar, I consulted 37 CFR Part 5 to determine the requirements of a Petition for Retroactive License under 37 CFR §5.25. Unfortunately, I inadvertently overlooked the sections of 37 CFR Part 5 pertaining to the grant of prospective licenses due to my mistaken belief that only a retroactive foreign filing license could solve my client's foreign filing problem. Furthermore, I failed to make inquiry to the PTO regarding this problem because at the time of the proscribed Canadian foreign filing, I believed I was diligently following the correct PTO procedures required to obtain a foreign filing license. Certainly, if I had been aware of the proper procedures for obtaining a prospective foreign filing license, I would have fully complied with those procedures prior to the Canadian filing.

In summary, although I knew a foreign filing license was required, I did not know that a foreign filing license could be obtained even though no U.S. Patent Application was on file at the U.S. Patent and Trademark Office. Consequently, because my client's invention had the same statutory bar date in both the U.S. and Canada, I filed the two applications contemporaneously and then promptly sought a retroactive foreign filing license based upon my belief that that was the proper PTO procedure in such instances. Furthermore, I diligently complied with the procedures for obtaining of a rectroactive foreign filing license by promptly filing my petition within one month of the proscribed foreign filing. Accordingly, the proscribed foreign filing occurred through error without any deceptive intent because the failure to obtain the required foreign filing license was not intentional or willful, but, rather, occurred only through my mistake as to the proper PTO procedures.

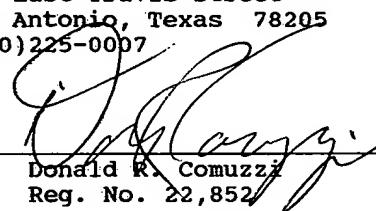
FURTHER DECLARANT SAYETH NOT.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and, further, that these statements are made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 USC §1001 and that such willful false statements may jeopardize the validity of the document, application or any patent issued thereon.

Respectfully submitted,

LAW OFFICES OF DONALD R. COMUZZI
1631 Milam Building
115 East Travis Street
San Antonio, Texas 78205
(210)225-0007

DATE: _____

By: 

Donald R. Comuzzi
Reg. No. 22,852

ATTORNEY FOR APPLICANT

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service "Express Mail, Post Office to Addressee" service under 37 CFR 1.10 on the date indicated below and addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Express Mail No. RB 901394 857 US Date 11 Aug 93


Ana I. Robinson